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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,196	01/29/2004	Anthony Balloutine	390.0002	2257
25534	7590	03/01/2006	EXAMINER	
CAHN & SAMUELS LLP 2000 P STREET NW SUITE 200 WASHINGTON, DC 20036			SUHOL, DMITRY	
			ART UNIT	PAPER NUMBER
			3725	

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,196

Applicant(s)

BALLOUTINE, ANTHONY

Examiner

Dmitry Suhol

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 19 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6, 8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Price '306. Prince discloses a substrate and associated disappearing ink markings, read onto penmanship improving indicia, (figures 1-17) which disappear through a water reactionary agent and are utilized as a guidance means for in a variety of uses (paragraph 0106). A cover, as required by claims 6-8 and 11, is read onto the sponge disclosed in paragraph 0105 which is treated with the water reactionary agent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherman '849 in view of Pitts' 297 or Hockaday '588. Sherman discloses a device containing most of the claimed elements including, a marked area (surface 14) having

ink capable of disappearing (ink 3), an overlying barrier sheet (12) for preventing permeation of air which is removably affixed to the marking surface (col. 3, lines 4-11).

Sherman fails to explicitly teach a barrier sheet of synthetic polymer material as required by claim 2, a barrier sheet being of a lightweight aluminum foil as required by claim 3, a plurality of lines (a penmanship improving indicia as required by claims 1 and 10) formed form a disappearing ink as required by claims 1 and 4 and a series of instructions located on the barrier sheet as required by claim 5. However, it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to have manufactured the barrier sheet of Sherman from a synthetic polymer or a lightweight aluminum foil since Sherman does not put forth any constraints regarding the materials used in the manufacture of his barrier (10) but that the barrier prevents air or light from reaching the reactive ink of his invention and the use of any of the above materials would be capable of fulfilling such a function. Furthermore, the specific materials of manufacture of the barrier sheet of applicants invention are considered to be a design choice in that applicants clearly admit that (much like Sherman) any materials may be used with the only constraint being that the barrier prevent the ink from being exposed to air (see applicants specification page 5, lines 3-9).

Regarding the indicia limitations of claims 1, 4 and 10, Sherman discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time of the claimed invention to provide the disappearing ink of Sherman in an arrangement of straight lines since it would only depend on the intended use of the

assembly and the desired information to be displayed and since Pitts and Hockaday both clearly teach that it is known to provide a substrate and indicia in a relationship such that the indicia disappears or is removed after functioning as a guide device (see Hockaday figures 1-3 and Pitts col. 1, lines 14-23). Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of disappearing indicia and guide means does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. a plurality of lines) and the substrate (e.g. the carrier sheet/substrate) which is required for patentability.

Regarding the instructions as required by claim 5, it would have been obvious to include a series of instructions located on the barrier sheet of Sherman for the purpose of providing instructions to the user of the device especially since the examiner takes official notice that such construction is conventional (i.e. peel back covers often have instructions stating items like "peel back here", or "pull up and peel back", etc).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Price '306. Although Price discloses all of the claim limitations, as stated above, the reference fails to explicitly teach an activation sheet of a lightweight aluminum foil as required by

claim 9. However, the specific materials of manufacture of the activation sheet of applicants invention are considered to be a design choice in that applicants clearly admit that any materials may be used and in fact clearly state that a synthetic polymer is the preferred choice of materials (see applicants specification page 7, paragraph 0030).

Response to Arguments

Applicant's arguments filed 10/19/2005 have been fully considered but they are not persuasive. Applicants argue that Prince does not anticipate claims 6-8 and 11 since the reference fails to teach "a writing surface including penmanship improving indicia". In response the examiner points out that no specific structure is claimed by the applicants regarding to the "penmanship improving indicia" and therefore the examiner has simply taken the broadest interpretation in the art of equating the grid lines of Prince with applicants "penmanship improving indicia" since both are essentially nothing more than grids lines on a substrate used for the placement of markings thereon. The examiner further points out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case the grid lines of Price can easily be utilized as penmanship improving indicia and therefore do not patentably distinguish the claim.

Applicants further argue that the combination of Sherman, Pitts or Hockaday does not disclose all of the claimed limitations. In support applicants state that guide

markings of Pitts and Hockaday are completely different than applicants claimed guide marks since the markings of Pitts do not disappear and since Hockaday uses releasable adhesive mounted parallel strips attached to a substrate. In response the examiner points out that neither Pitts or Hockaday is relied upon to teach the chemical relationship between the substrate, cover and ink composition (already taught by Sherman) but rather the teaching that positioning and removal of indicia on a substrate for penmanship purposes is known and therefore would have been obvious. Regarding the Pitts reference and its indicia the examiner directs applicants attention (Pitts, col. 1, lines 14-23) which clearly discusses the state of prior art and removal of the above type of indicia.

Conclusion


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Dmitry Suhol
Primary Examiner
Art Unit 3725

ds